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IN THE

Supreme Court of the United States

OCTOBER TERM, 1964

No. 396

BELL HOSIERY MILLS, INC., *Petitioner*

vs.

MARVEL SPECIALTY COMPANY, INC., *Respondent*

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

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THE QUESTIONS PRESENTED BY THE PETITION

The five questions presented by Petitioner are not meaningful legal issues raised by the decisions of the courts below. No one could sensibly argue that any of the Petitioner's five questions should be answered in the affirmative, and nothing said by the courts below raises such questions. The Petitioner is simply dissatisfied with the way in which the courts below have applied well settled legal principles to the facts of this case. There is no genuine question about the

law as applied by the courts below being in conflict with decisions of other Courts of Appeal, or being in any way inconsistent with the law declared by this Court. Consequently, Petitioner has been unable to frame any legal issue which would justify consideration by this Court. Petitioner's Questions Presented are simply self-answering propositions which are phrased to suggest that the Court is denouncing virtue and justice if it fails to grant petitioner's request for a writ.

SUPPLEMENTAL STATEMENT OF THE MATTER INVOLVED

The invention covered by the patent in suit was made by Merle Brown, a mill worker, and exploited by a small company made up of Brown and a few associates. The machine covered by the patent was the first of its kind. In speaking of the Brown invention the District Court said:

* * * * * * * * *

"The Brown apparatus is the first machine ever devised for the correction of pulled threads in hosiery—unless the Hutchison hand implement be termed a 'machine'.

* * * * * * * * *

"As a result of the Brown patent, the cost of mending was reduced from 70 cents to 25 cents per dozen of hose while increasing the earnings of menders and making practical the mending of long pulls. Mending pulled threads was changed from a slow hand operation to a mass production type machine operation.

* * * * * * * * *

"The first effort to lease a machine embodying the Brown patent occurred in November of 1949. Within three and a half months thereafter, every

> major hosiery mill in the United States had taken a lease. Within approximately eight months, around 635 hosiery mills had accepted leases, comprising 90 per cent of the hosiery industry.
>
> * * * * * * * * *
>
> "There was no patent literature on machines for mending pulled threads prior to the Brown invention." 216 F. Supp. at 826-827.

The Brown patent covers a pioneer or primary invention and the doctrine of equivalents is clearly applicable in interpreting its claims, *Graver Tank and Mfg. Co.* v. *Linde-Air Products Co.*, 339 U.S. 605 at 608 (1950).

The Petitioner's brief (page 7) suggests that the District Court found that the Mend-More machine did not infringe the Brown patent because it found *as a matter of fact* that the patented machine and the accused machine did not operate in the same way. This is an incorrect analysis of the District Court's decision. The District Court found that the doctrine of equivalents as explained in this Court's *Graver Tank* decision was applicable except that the patentee was precluded from claiming the benefits of the doctrine because of representations he had made when soliciting his claims before the Patent Office. The District Court said:

> "Except for the Hutchison prior art, the Graver Tank doctrine of equivalents ought perhaps to be applied to the Mend-More device, but, in view of Hutchison, the broad construction urged by plaintiff for the Brown patent cannot be allowed. To apply the doctrine of equivalents in this case would ignore the teachings of the patent, the representations upon which the claims in suit were allowed, and the representations by which the

> validity of the Brown patent has been sustained in the prior portion of this opinion." 216 F. Supp. at 828.

It is quite apparent that the District Court believed that the patentee was estopped from claiming the benefits of the *Graver Tank* doctrine because of representations made to the Patent Office. The District Court, incidentally, took this position as a result of arguments made by Petitioner in its briefs. The arguments were plainly wrong. The Respondent pointed this out to the Court of Appeals and reprinted the entire file history of the Brown patent in its brief so that the Court of Appeals could make its own study and thus its own evaluation of the position which the Petitioner had urged the District Court to adopt. The Circuit Court did this, and stated in its opinion:

> "In conclusion, we have carefully reviewed the file wrapper of the Brown patent to determine if there is any representation therein which should estop the plaintiff from claiming that the Mend-More infringes its invention. We have found none. The Hutchison device was not cited against any of the apparatus claims of the Brown patent. No representations based upon the circular series of impacting elements were made to distinguish the Brown invention from the Hutchison device." 330 F.2d at 177.

The Petitioner's statement of matters involved also fails to mention that the patented machine involves much more than the single element pictured in its brief, and that with respect to these several other elements, the accused Mend-More machine copies them in detail. With respect to the single element which differs, the element used in the accused machine was

a well known equivalent to that employed by the patentee.

> "Since the impact elements of both the Marvel and Mend-More machines travel in substantially the same path through the working area, the action of the elements of each machine on the fabric is, as the District Court found, 'closely similar.' Additionally, it should be noted that the movement achieved in the Mend-More by the eccentric connection of the blade to the hub is an old and well known mechanical movement which could be readily adapted to produce the action upon the fabric achieved by the Marvel machine." 330 F.2d at 176.

THE REASONS FOR DENIAL OF THE WRIT

I. There Is No Conflict in the Ways in Which the Various Courts of Appeal Have Interpreted and Applied the Graver Tank Case Rule on Equivalents

The *Graver Tank* case was decided by this Court about fourteen years ago. If there existed in the decisions of the various circuit courts the "wholesale confusion" which the petitioner visualizes it would be reasonable to expect that at least passing mention of this would have been made either in the law journals or in the opinions of the courts. Petitioner, however, is apparently the first one to suggest that "wholesale confusion" exists in this area of patent law.

It is of course evident from the opinion of the Court below that it attempted to follow carefully the rule of equivalency as explained by this Court in the *Graver Tank* case. 330 F.2d at 176. The Petitioner, however, undertakes to show that there is a significant difference between the rule as applied by the Court below and as applied by the Courts of Appeal for the Second and Seventh Circuits.

The Petitioner commends the Second Circuit for limiting the application of the doctrine to *minor* omissions or *minor* changes, and states that the Court below disregarded such limitations on the doctrine. The *Graver Tank* case, carefully followed by the Court below, speaks of the doctrine as being applicable to "unimportant and insubstantial changes and substitutions," and the Petitioner asserts that this too was disregarded by the Court below.

The Petitioner's argument overlooks the most important aspect of the *Graver Tank* case. This case not only tells that the doctrine of equivalents is limited to "unimportant and insubstantial changes and substitutions" but it also provides the standard for determining whether a change or substitution is substantial or insubstantial. It teaches that a change or substitution is insubstantial:

> "if it performs substantially the same function in substantially the same way to obtain substantially the same result." 339 U.S. at 608.

There can be no question that the Court below carefully applied this test. It is therefore inherent in the decision of the Court below finding infringement that the differences between the accused Mend-More device and the patented device were unimportant and insubstantial. These terms, like minor or major, are merely an expression of the conclusion reached by application of the test.

The Petitioner seems to argue for a rather strange interpretation of the *Graver Tank* opinion. It does not dispute the necessity of comparing an accused device with a patented one to determine if it performs substantially the same function in substantially the

same way to obtain the same result. However, Petitioner seems to suggest that if this rule is found applicable one should then apply the additional test of whether the differences between the accused device and the patented one are major or minor. This, of course, is the purpose of applying the test in the first instance.

The Petitioner suggests that the decision of the Court of Appeals for the Seventh Circuit in *Union Carbide and Carbon Corp.* v. *Graver Tank and Mfg. Co., Inc., et al.*, 196 F.2d 103, at 112 is the proper exposition of the doctrine of equivalents (Petitioner's Brief, page 12). It quotes therefrom as follows:

> "In our opinion, the application of the doctrine of equivalency in this case is to ignore the teachings of the patent, the representation upon which the claims in suit were allowed and, more pointedly perhaps, the representations by which their validity has been sustained in the courts."

This is precisely the view of the doctrine which was applied by the Court below. The Court said:

> "In conclusion, we have carefully reviewed the file wrapper of the Brown patent to determine if there is any representation therein which should estop the plaintiff from claiming that the Mend-More infringes its invention. We have found none." 330 F.2d at 177.

The Court also said:

> "As previously stated, the District Court felt that the prior art Hutchison device precluded its giving a scope to the invention which would cover the single blade Mend-More. The court emphasized that to apply the doctrine of equivalents to the single blade device would ignore the basis

upon which it had sustained the patent's validity, and stated: 'The claims of the Brown patent 7, 4, 2 and 1 fail to cover the Mend-More device by the very same point or points of novelty that distinguish the claims over Hutchison. In this determination we are of the opinion that the District Court was in error." 330 F.2d at 176-177.[1]

It is quite apparent, therefore, that there is no disparity between the application of the doctrine of equivalents by the Court below and that of the Court of Appeals for the Seventh Circuit since both apply the same limiting principles. In fact, all of the cases cited by the petitioner take the same view of the doctrine, and universally apply the test of whether the devices in question perform substantially the same function in substantially the same way to obtain the same result. The variations in language which are used to express the conclusions reached upon applying this test do not support Petitioner's position that wholesale confusion exists.

The Petitioner correctly speaks of the doctrine of equivalents as a judicially created rule, but fails to make clear that following the *Graver Tank* decision the doctrine was incorporated into the patent statutes, and its existence thereby recognized and approved by Congress. See third paragraph, 35 U.S.C. § 112, *infra*, page 9.

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[1] The Court below went on to point out that an earlier portion of the District Court's opinion made it quite clear that it had found patentability on the basis of differences over the prior art which were common to both the patented Marvel machine and the accused Mend-More machine. It should be noted that the Court below did not in any respect challenge the basis on which the District Court had found patentability but merely pointed out that the District Court's opinion contained a self-evident contradiction.

The dissenting opinion by Justices Black and Douglas in the *Graver Tank* case was based on the consideration that Congress had provided that a patent applicant shall particularly point out and distinctly claim his invention or discovery and that the judicially created doctrine of equivalency was inconsistent with this Congressional enactment. This objection to the doctrine is no longer applicable since about two years after the *Graver Tank* case decision Congress incorporated into the patent statutes the provision above referred to which recognizes the existence of the doctrine. It is significant that this recognition of the doctrine of equivalents appears as an addition to the statutory provision requiring the inventor to particularly point out and distinctly claim his invention. The codifying paragraph states:

> "An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof and *such claim shall be construed to cover* the corresponding structure, materials or acts described in the specification and *equivalents thereof.*" 35 U.S.C. § 112.

During the trial of this case in the District Court the Petitioner urged the District Court to find that the Respondent was not entitled to the benefit of the doctrine of equivalents because of representations made to the Patent Office concerning its device. The District Court so found. This position, however, was so obviously incorrect in view of the file wrapper documents that the Petitioner did not even attempt to defend the position on appeal but, instead, argued a new theory. The Court of Appeals took note of this in saying:

> "In its opinion, the District Court indicated that plaintiff had secured the issuance of its patent by

> representing to the Patent Office that its invention was different from the Hutchison device because of the circular arrangement of plural needles. On appeal the defendant has not attempted to defend that position but has argued instead that plaintiff secured the patent by erroneous representations as to the method by which its invention operated." 330 F.2d at 177, footnote 21.

In its brief before this Court, the Petitioner is reverting to the discredited argument which initially led the District Court into error. See the first full paragraph of the Petitioner's Brief, page 10 and the second paragraph which states that the instant case is one in which the doctrine of equivalents was applied "without regard to the prior art or to the basis upon which the patent was granted by the Patent Office." This is an unfair characterization of the work done by the Court of Appeals since it carefully discussed both of these points in its opinion.

Petitioner suggests that the Respondent chose the Fourth Circuit as a forum because it had a more liberal view of the doctrine of equivalents than did the Second Circuit in which the manufacturer of the infringing devices was located (Petitioner's Brief, page 14). This speculation on the part of the Petitioner is completely fanciful. The Respondent chose to sue in the Fourth Circuit because the defendant in this action was the only mill operator known to Respondent who was operating both types of infringing machines. At the time of suit Respondent's patent also contained a method claim which could be asserted only against operators of the accused machinery, and not against the manufacturer. The Respondent will have no need to plead the Fourth Circuit's decision against the man-

ufacturer in the Second Circuit since the manufacturer openly defended this action, as mentioned in the opinions of both Courts below, and is therefore already bound by the decision.

CONCLUSION

The Petitioner bases its writ on alleged utter and wholesale confusion among the Courts of Appeal concerning the doctrine of equivalents. In fact, this Court's rule in the *Graver Tank* case is uniformly understood and applied and in the present case it is clear from the opinion of the Court below that it applied to the facts of this case an exposition of the doctrine which the Petitioner itself has characterized as exemplary. The writ should be denied.

Respectfully submitted,

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CERTIFICATE OF SERVICE

Three copies of the foregoing Brief in Opposition to Petition for a Writ of Certiorari to the United States Court of Appeals for the Fourth Circuit have been served on the Petitioner by mailing said copies first class airmail, postage prepaid, to petitioner's attorney, Warley L. Parrott, Esq., 13th Floor, Johnston Building, Charlotte, North Carolina.

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